REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 23, 2006 ("Office Action"). At the time of the Office Action, Claims 1-9, 11-20, 31, and 32 were pending and stand rejected. Applicant amends Claims 1, 9, and 11 and cancels Claims 2 and 12. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

Section 103 Rejections

The Examiner rejects Claims 1-9, 11-20, and 31-32 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of U.S. Patent No. 6,125,390 issued to Touboul ("*Touboul*") and U.S. Patent No. 5,761,502 issued to Jacobs ("*Jacobs*") with U.S. Patent No. 6,011,838 issued to Cox ("*Cox*"), U.S. Patent No. 5,748,098 issued to Grace ("*Grace*"), U.S. Patent No. 5,440,688 issued to Nishida ("*Nishida*") and U.S. Patent No. 5,933,601 issued to Fanshier et al. ("*Fanshier*"). Because the proposed combination(s) of references do not disclose, teach, or suggest each and every element of Applicant's claims, Applicant requests reconsideration and allowance of Claims 1-9, 11-20, and 31-32.

A. The Claims are Allowable over the Proposed Combinations

First, Applicant respectfully submits that each and every limitation of Applicant's claims is not disclosed, taught, or suggested by the proposed combinations. For example, independent Claim 1 of the present application, as amended, recites:

> A method for reporting the context of an alert condition, comprising:
> reporting an alert condition associated with a subject system object;
> receiving, in response to the reporting of the alert condition, a user-generated dialogue request requesting context data;
> accessing a database to identify a group of system objects known to be associated with one another;

  identifying, from the group of system objects, a relevant system object that is known to be associated with the subject system object;

  analyzing the subject system object associated with the alert condition and the relevant system object to obtain context data;

  generating a context message based on the context data, the context message responsive to the user-generated request dialogue; and

  outputting the context message.

In the Office Action, the Examiner relies upon the *Touboul-Jacobs* combination to reject Applicant's Claim 1. Applicant respectfully submits, however, that the proposed *Touboul-Jacobs* combination does not disclose, teach, or suggest each and every element of Applicant's Claim 1.

For example, the proposed *Touboul-Jacobs* combination does not disclose, teach, or suggest "receiving, in response to the reporting of the alert condition, a user-generated dialogue request requesting context data," as recited in Applicant's Claim 1. With respect to now canceled Claim 2, the Examiner relies upon *Touboul* for disclosure of "receiving a request." The relied upon portion of *Touboul* merely discloses, however:

> The event log manager module 42 communicates each alert to an event list manager module 46. This module 46 reads each new event and displays it on the display at the computer on which the management console 1 resides within one of the views set up by the administrator, after the module 46 filters out those events or alerts which are not requested in the selected statistical view 7 or event view of 6.

(Column 14, lines 20-25). Thus, the *Touboul* system sends all alerts from the event log manager module 42 to the event list manager module 46, but the alerts are then filtered by the manager module 42 before they are displayed. For example, *Touboul* discloses that "the administrator can set up on or more event views 6 which display different alerts from certain or all workstations in the network." (Column 8, lines 30-33). *Touboul* (and, thus, the *Touboul-Jacobs* combination, as relied upon by the Examiner) does not disclose, teach,

or suggest "receiving, in response to the reporting of the alert condition, a user-generated dialogue request requesting context data," as recited in Applicant's Claim 1.

For similar reasons, Applicant also respectfully submits that the proposed *Touboul-Jacobs* combination does not disclose, teach, or suggest "generating a context message based on the context data, the context message responsive to the user-generated request dialogue," as recited in Claim 1. In the Office Action, the Examiner relies upon *Touboul* for disclosure of "generating a context message." To the extent that *Touboul* discloses such an operation (which Applicant does not admit), the message generated by *Touboul* is not "responsive to the user-generated request dialogue," as recited in Claim 1. As shown by Applicant above, user-generated request dialogue is absent from the disclosure of *Touboul*. Further, *Touboul* merely discloses that an "agent 14 monitors the applications and the operating system and when an interrupt is generated . . . determines if there is an error condition." (Column 7, lines 39-41). "If so, . . . the alert is sent by the agent to the monitor 2 and includes identification of the type of problem, the workstation on which it occurred, the name of the program which caused the error, and a recommended corrective action. This recommended action can be modified by the administrator before it is executed." (Column 7, lines 41-48). There is no disclosure in the cited portion of "generating a context message based on the context data, the context message responsive to the user-generated request dialogue," as recited in Claim 1.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1.

The Examiner also relies on the *Touboul-Jacobs* combination to reject independent Claims 9 and 11. Applicant respectfully submits, however, that the *Touboul-Jacobs* combination does not disclose, teach, or suggest each and every element of Applicant's independent Claim 9. For example, Claim 9 recites "means for receiving, in response to the reporting of the alert condition, a user-generated dialogue request requesting context data" and "means for generating a context message based on the context data, the context

message responsive to the user-generated request dialogue." As another example, Claim 11 recites "logic encoded in media and operable when executed to . . . receive, in response to the reporting of the alert condition, a user-generated dialogue request requesting context data . . . [and] generate a context message based on the context data, the context message responsive to the user-generated request dialogue." Thus, for reasons analogous to those discussed above with regard to Claim 1, Applicant respectfully submits that the *Touboul-Jacobs* combination does not disclose, teach, or suggest each and every element set forth in Applicant's independent Claims 9 and 11.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 9 and 11.

Dependent Claims 2-8 and 31-32 depend on Claim 1, which Applicant has shown above to be allowable. Dependent Claims 12-20 depend on Claim 11, which Applicant has shown above to be allowable. Additionally, Claims 2-8, 12-20, and 31-32 are patentable because they recite additional features and operations not disclosed, taught, or suggested in the prior art. Since Claims 2-8, 12-20, and 31-32 incorporate the limitations of their respective independent claims, Applicant has not provided detailed arguments with respect to Claims 2-8, 12-20, and 31-32. However, Applicant remains ready to do so if it becomes appropriate. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 2-8, 12-20, and 31-32.

B.   The Proposed Combinations are Improper

Second, Applicant respectfully submits that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to make the proposed combinations of references. Applicant's claims are allowable for at least this additional reason.

1.   The Legal Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The governing Federal Circuit case law makes this strict legal standard clear.[1] According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet,* 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) *(holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's

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[1] Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "*The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*" M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*'" *In re Kotzab,* 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id. See also, e.g., Grain Processing Corp. v. American Maize-Products,* 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention*:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

2. The *Touboul-Jacobs* Combination

According to the Examiner and with regard to independent Claims 1, 9, and 11, "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of *Touboul* and *Jacobs* because Jacobs*'s* teaching of accessing a database to identify a group of system objects known to be associated with one another would increase the alertness of network management personnel by providing a view of the current state of the network that correlates related network events (col. 2, lines 29-65)." (Office Action, page 3). It appears that the Examiner has merely proposed an alleged advantage of combining *Touboul* with *Jacobs* (advantages which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited a portion of *Jacobs* that tout an advantage of its Network Topology Object Database, the Examiner has not pointed to any portions of the cited references that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the computer network monitoring and controlling system disclosed in *Touboul* with the Network Topology Object Database applicable to a telecommunication network as disclosed in *Jacobs*. In other words, the alleged advantage of the system disclosed in *Jacobs* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Touboul* with the cited disclosure in *Jacobs*; (2) how one of ordinary skill in the art at the time of Applicant's

invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Applicant's claims. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

Furthermore, whereas *Touboul* relates to the field of managing applications on network workstations in a computer network (Abstract; Figure 1), *Jacobs* relates to the very different field of correlating network events in a telecommunications network. (Abstract). In addition to being outside the field of technology of *Touboul*, the telecommunications network of *Jacobs* does not even remotely deal with the same types of problems encountered by networked computer systems. As such, Applicant respectfully submits that there is no explicit or implicit reference in either reference which would suggest to one of ordinary skill to combine the correlating of network events in a telecommunications network as disclosed in *Jacobs* with the networked computer system of *Touboul*. In this respect, Applicant respectfully submits that the references are non-analogous art and, because not related, an improper combination. Applicant respectfully submits that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicant's claims as a blueprint, in an attempt to reconstruct Applicant's claims. It is clear based at least on the many distinctions between the references that the proposed *Touboul-Jacobs* combination does not, taken as a whole, suggest the claimed invention, taken as a whole.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Touboul* with *Jacobs* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal

Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 1, 3-9, 11, 13-20, and 31-32.

3.   The *Touboul-Jacobs-Cox* Combination

According to the Examiner and with regard to independent Claims 6 and 16, "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Touboul*, *Jacobs*, and *Cox* because *Cox's* teaching of determining a traffic load would increase the efficiency of *Touboul's* and *Jacob's* systems by minimizing the amount of failure caused by overloading a system object (col. 1, lines 11-15)." (Office Action, page 5). Again, it appears that the Examiner has merely proposed an alleged advantage of combining *Touboul* and *Jacobs* with *Cox* (advantages which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited a portion of *Cox* that tout an advantage of its techniques for determining a traffic load, the Examiner has not pointed to any portions of the cited references that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the network monitoring and controlling system disclosed in *Touboul* with the Network Topology Object Database applicable to a telecommunication network as disclosed in *Jacobs* and the traffic load determination techniques disclosed in *Cox*. In other words, the alleged advantage of the system disclosed in *Cox* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Touboul* and *Jacobs* with the disclosure of *Cox*; (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Applicant's claims. Applicant respectfully submits that if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that

reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

Furthermore, it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the particular techniques disclosed in *Touboul* and *Jacobs* with the traffic determination techniques of *Cox* in the manner proposed by the Examiner.[2] As described in the previous Response to Office Action submitted on October 6, 2005, *Touboul* relates to "a method and apparatus which automatically detects and corrects error conditions occurring in programs running on network workstations." (Column 1, lines 12-15). Specifically, the system of *Touboul* identifies the error-causing application and applies a corrective measure to address the identified problem. In contrast, *Cox* relates to a system that "dynamically and automatically determines the correct peak hour and average usage at that hour (or other time period) for selected components of network elements like a switch." (Column 3, lines 30-33). As a result, "the load on the selected component may be adjusted or the network otherwise reconfigured." (Column 3, lines 46-47). In addition to being outside the field of technology of *Touboul*, the traffic load determination system of *Cox* does not deal with the same types of problems encountered by fault-detection systems such as *Touboul*. For example, *Cox* explicitly states that the objective of the disclosed packet telephony system is to provide "more accurate usage data . . . [to allow] traffic engineers to take proactive measures to prevent new conditions from impacting service." (Column 3, lines 56-59). Thus, the solution proposed by *Cox* is designed to prevent system failures. As a result, one of ordinary skill in the art would not have been motivated to combine the traffic determination techniques of *Cox* with the system of

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[2] If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicant respectfully requests that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicant respectfully requests that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

Touboul, which is designed to detect, report and correct program errors (Column 4, lines 6-7). In this respect, Applicant respectfully submits that the references are non-analogous art and, because not related, an improper combination.

The identified differences in *Touboul* and *Cox* provide evidence that one of ordinary skill in the art at the time of Applicant's invention would have considered the references as relating to different fields of invention and would not made the proposed combination. Applicant respectfully submits that the Examiner's attempt to modify or combine *Touboul* with *Jacobs* and *Cox* appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases. Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Touboul* with *Jacobs* and *Cox* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of dependent Claims 6 and 16.
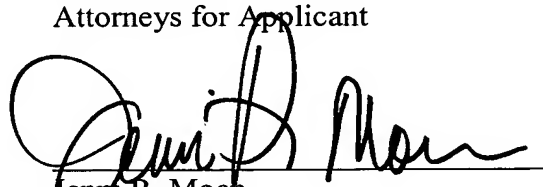
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 953-6809.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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